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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,386	04/18/2001	Susumu Honma	109296	7176

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/836,386	Applicant(s) HONMA ET AL.	
	Examiner Fred I. Ehichioya	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 16 are pending in this Office Action.

Claim Rejections - 35 USC § 101

2. Applicants' amendment to claims 1, 4, 5, 8 13 and 15 overcame the rejection under 35 U.S.C. § 101. Therefore the rejection under 35 U.S.C. § 101 is hereby withdrawn.

Claim Rejections - 35 USC § 112

3. Applicants' amendment to claims 13 and 15 overcame the rejections under 35 U.S.C. § 112, first and second paragraphs. Therefore the rejections under 35 U.S.C. § 112 are hereby withdrawn.

Response to Arguments/Remarks

4. Applicants' arguments, with respect to claims 1 – 16 have been fully considered and but are not are persuasive. Therefore, the rejection under 35 U.S.C. § 103 of last Office Action is proper.

Applicants argue:

(a) *Shimotsuji and Smith, alone or in combination, do not teach or suggest a data input form retrieving text file containing the extracted character strings in association with a corresponding data input form, extracting condition extracts the*

specific data input form by retrieving the character string contained in the text file . . . as recited in claim 1, and similarly recited in claim 5 (page 8, paragraph 3).

Examiner respectfully disagrees with the applicants. Section 13 on pages 11 – 13 of last Office Action rejects claims 13 and 15. However, applicants' argument is based on claims 1, 5 and 9. Therefore, the rejection of claims 1 and 5 is proper. Shimotsuji and Reuning teach the limitations of claims 1, similarly in claim 5 and in claim 9. Particularly, examiner wishes to point out that Reuning teaches text file containing the extracted character strings in association with a corresponding data input form (see column 5, lines 43 – 49 and column 7, lines 10 – 17); and retrieving the character string contained in the text file in accordance with the extracting condition inputted by the extracting condition input unit (see column 7, lines 10 – 17) as underlined the above argument.

(b) Shimotsuji and Smith, alone or in combination, fail to teach or suggest a data input form retrieving system keyword inputted by a user or automatically generated by natural language analysis to each of plural data input forms, by retrieving the keyword added by the keyword adding unit in accordance with the extracting condition inputted by the extracting condition input unit, , as recited in claim 4, similarly recited in claim 8, and in claim 12 (page 8, paragraph 4).

In response to applicants' argument, examiner wishes to submit that Shimotsuji teaches a keyword adding unit that adds a keyword inputted by a user or automatically generated by natural language analysis to each of plural data input forms (see column 1, lines 33 – 36); and a data input form extracting unit that extracts the

specific data input form by retrieving the keyword added by the keyword adding unit in accordance with the extracting condition inputted by the extracting condition input unit (see column 2, lines 2 – 5) as claimed in claims 4, 8 and 12.

(c) *Shimotsuji and Smith do not teach or suggest a data input form retrieving system, comprising . . . in accordance with a predetermined rule for extracting the character string from a specific kind of character string, . . . as recited in added claim 13, and similarly recited in claim 15 (page 9, paragraph 2).*

In response to applicants' argument that the references fail to show certain features of applicants' invention, it is noted that the features upon which applicant relies (i.e., "in accordance with a predetermined rule for extracting the character string from a specific kind of character string") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(d) *Prima facie obviousness has not been established for lack of clear and particular evidence of motivation to combine the references (page 10, paragraph 2 and 3).*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shimotsuji teaches a data input form extracting computer unit that extracts the specific data input form (column 2, lines 2 – 5) and Reuning teaches text file containing the extracted character strings in association with a corresponding data input form (see column 5, lines 43 – 49 and column 7, lines 10 – 17). By combining the teaching of text file containing the extracted character strings of Reuning with the features relating to the data line extraction of Shimotsuji' would have allowed Shimotsuji's system to locate Internet site pages and web postings which contain operator specified keywords or Boolean combinations and then extracts all email addresses from those pages as well as linked pages as suggested by Reuning (column 3, lines 10 - 15).

Further, the advantage is that the user is not required to conduct or observe the cumbersome, tedious, frustrating and agonizingly slow task of reviewing data contained on Internet web sites, newsgroup postings and other data sources that may exist from time to time on the net (Reuning: column 3, lines 28 – 31)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 - 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,815,704 issued to Shigeyoshi Shimotsuji et al (hereafter "Shimotsuji") in U. S. Patent 6,381,592 issued to Stephen Michael Reuning (hereinafter "Reuning").

Regarding claim 1, Shimotsuji discloses a data input form retrieving system, comprising:

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a character string extracting computer unit that extracts a character string from each of plural data input forms containing character strings (see column 1, lines 55 – 57 and column 4, lines 2 – 6).

an extracting conditions input computer unit that inputs a condition of extracting a specific data input form from the plural data input forms (see column 2, lines 15 – 17);

a data input form extracting computer unit that extracts the specific data input form (see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach text file as claimed.

However, Reuning teaches text file containing the extracted character strings in association with a corresponding data input form (see column 5, lines 43 – 49 and column 7, lines 10 – 17); and

retrieving the character string contained in the text file in accordance with the extracting condition inputted by the extracting condition input computer unit (see column 7, lines 10 – 17).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Reuning's teaching of "text file containing the extracted character strings in association with a corresponding data input form" would have allowed Shimotsuji's system enable users to search and "locates Internet site pages and web postings which contain operator specified keywords or Boolean combinations and then extracts all

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email addresses from those pages as well as linked pages" as suggested by Reuning (column 3, lines 10 - 15).

Further, the advantage is that the user is not required to conduct or observe the cumbersome, tedious, frustrating and agonizingly slow task of reviewing data contained on Internet web sites, newsgroup postings and other data sources that may exist from time to time on the net (Reuning: column 3, lines 28 – 31).

Regarding claims 2, 6 and 10, Reuning teaches wherein all the character strings contained in each of the plural data input forms are extracted (see column 3, lines 12 – 13 "extracts all email addresses from those pages as well as linked pages" - pages are forms and column 7, lines 11 – 17 "character strings representative of electronic mail addresses and saves those addresses in memory or disk storage. Presently, the electronic mailing protocol dictates that a filtering algorithm be used as follows: extract any string of characters that fits "space" _*@"_*_"space" where "*" is a wildcard variable representing any combination of characters").

Regarding claims 3, 7 and 11, Reuning teaches wherein a specific character string is selected out of the character strings contained in the plural data input forms (see column 7, lines 26 – 31).

Regarding claims 4, 8 and 12, Shimotsuji teaches a computer implemented data input form retrieving system, comprising:

a keyword adding computer unit that adds a keyword inputted by a user or automatically generated by natural language analysis to each of plural data input forms (see column 1, lines 33 – 36);

an extracting condition input computer unit that inputs a condition of extracting a specific data input form from the plural data input forms see column 2, lines 15 – 17);

and a data input form extracting computer unit that extracts the specific data input form by retrieving the keyword added by the keyword adding unit in accordance with the extracting condition inputted by the extracting condition computer input unit (see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach a text file as claimed.

Reuning teaches a text file containing the keywords extracted from the data input form is made up when the keywords have been extracted from each of the plural data input forms (see column 6, lines 16 – 26).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Reuning's teaching of "text file containing the extracted character strings in association with a corresponding data input form" would have allowed Shimotsuji's system enable users to search and "locates Internet site pages and web postings which contain operator specified keywords or Boolean combinations and then extracts all

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email addresses from those pages as well as linked pages” as suggested by Reuning (column 3, lines 10 - 15).

Further, the advantage is that the user is not required to conduct or observe the cumbersome, tedious, frustrating and agonizingly slow task of reviewing data contained on Internet web sites, newsgroup postings and other data sources that may exist from time to time on the net (Reuning: column 3, lines 28 – 31).

Regarding claims 5 and 9, Shimotsuji teaches a computer implemented data input form retrieving method, comprising:

extracting a character string from each of plural data input forms containing character strings (see column 3, lines 46 – 47 and column 4, lines 2 – 6);
inputting a condition of extracting a specific data input form from the plural data input forms (see column 6, lines 8 – 20).

Shimotsuji does not explicitly teach text file as claimed.

However, Reuning teaches making up a text file containing the extracted character strings in association with a corresponding data input form (see column 5, lines 43 – 49); and

extracting the specific data input form by retrieving the extracted character string contained in the text file in accordance with the inputted extracting condition (see column 7, lines 10 – 17).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Reuning's teaching of "text file containing the extracted character strings in association with a corresponding data input form" would have allowed Shimosuji's system enable users to search and "locates Internet site pages and web postings which contain operator specified keywords or Boolean combinations and then extracts all email addresses from those pages as well as linked pages" as suggested by Reuning (column 3, lines 10 - 15).

Further, the advantage is that the user is not required to conduct or observe the cumbersome, tedious, frustrating and agonizingly slow task of reviewing data contained on Internet web sites, newsgroup postings and other data sources that may exist from time to time on the net (Reuning: column 3, lines 28 – 31).

Regarding claims 14 and 16, Shimotsuji teaches wherein the character string part is a noun part or a non-sentence part (see column 1, lines 55 – 66).

7. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimotsuji in view of U.S. Patent 5,438,682 issued to Ryohei Kumagai (hereinafter "Kumagai").

Regarding claim 13, Shimotsuji teaches a data input form retrieving system, comprising:

a character string extracting computer unit that extracts a character string from each of plural data input forms containing character strings in accordance with extracting condition (see column 1, lines 55 – 57 and column 4, lines 2 – 6).

a data input form extracting computer unit that extracts the specific data input form by retrieving the character string extracted by the character string extracting unit in accordance with the extracting condition inputted by the extracting condition input computer unit (see column 2, lines 2 – 5).

Shimotsuji does not explicitly teach inputs a condition of extracting a specific data as claimed.

Kumagai teaches an extracting condition, input computer unit that inputs a condition of extracting a specific data input from the plural data input forms (see column 3, lines 32 - 42).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Kumagai's teaching of "extracting condition, input computer unit that inputs a condition of extracting a specific data input from the plural data input forms" would have allowed

Shimosuji's system solve the problems associated with image processing system of wide usage; and also provides a large quantity digital processing system of wide usage and performance as suggested by Kumagai (see Summary).

Regarding claim 15, Shimotsuji teaches a computer implemented data input form retrieving method, comprising:

extracting a character string from each of plural data input forms containing character strings in accordance with the extracting condition (see column 1, lines 55 – 57 and column 4, lines 2 – 6); and

extracting the specific data input form by retrieving the extracted character string in accordance with the inputted extracting condition (see column 2, lines 15 – 17).

Shimotsuji does not inputting a condition of extracting a specific data as claimed.

However, Kumagai teaches inputting a condition of extracting a specific data input form from the plural data input forms (see column 3, lines 32 - 35).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Kumagai's teaching of "inputting a condition of extracting a specific data" would have allowed Shimosuji's system solve the problems associated with image processing system of wide usage; and also provides a large quantity digital processing system of wide usage and performance as suggested by Kumagai (see Summary).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

November 2, 2005


SHAHID ALAM
PRIMARY EXAMINER